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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,856	06/09/1999	PHILIP T. DAVIS	3144.01A	7390
7590	10/24/2003		EXAMINER	
RICHARD H ZAIRLEN ESQ PILLSBURY WINTHROP LLP 725 S. FIGUEROA STREET SUITE 2800 LOS ANGELES, CA 90017-5443			RIMELL, SAMUEL G	
			ART UNIT	PAPER NUMBER
			2175	
			DATE MAILED: 10/24/2003	23

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/328,856	DAVIS ET AL.	
	Examiner Sam Rimell	Art Unit 2175	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 46-64 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 46-64 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

  
**SAM RIMELL**  
**PRIMARY EXAMINER**

Art Unit: 2175

Preliminary Notes: This application was suspended from prosecution to permit consideration of pending application 08/338,350, which was pending at the time of suspension and which has subsequently matured into US Patent 6,604,080. Examiner has reviewed this patent and found that it is not applicable to the present claims of record. It is cited on PTO Form 892 which accompanies this action.

This office action includes new grounds of rejection which were not previously cited of record. Accordingly, this office action is made non-final, and re-sets the statutory period for response.

This office action includes indications of allowable subject matter, and includes suggestions for resolving the issues raised herein.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 60-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 60-64: Claims 60 sets forth an insurance policy and a means for calculating which appear to be unrelated to each other, and which do not operate together. However, this can be corrected by re-characterizing the claim as being a computer system, where the computer system has instruction which requests input of the of the insurance policy and trust details and instructions which calculate the premiums resulting from that input. Claims 61-64 are rejected for their dependency from claim 60, but do not require any further correction.

35 U.S.C. 101 reads as follows:

Art Unit: 2175

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 46-59 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

Claims 46-59: Claim 46 appears to be a pure algorithm which is not applied to physical elements, and merely creates a re-grouping on information. See *In re Scharader* 30 USPQ 2d 1455 (CAFC 1994). This can be corrected by stating that data on premiums and benefits are input to a computer system, and the computer system calculates benefits which are equal to the contribution payments. Claims 47-59 depend from claim 46, but do not require further correction.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 46-50, 52 and 54-62 are rejected under 35 U.S.C. 102(e) as being anticipated by Schoen et al. (U.S. Patent 6,235,176).

Claim 46: Schoen et al. discloses a computer system which calculates premiums and disability insurance payments for a disability insurance policy whose proceeds are used to fund payments to a defined contribution retirement savings plan (See col. 7, lines 3-24). As seen from col. 4, lines 61-63 and col. 9, lines 21-24, the disability insurance policy is a feature of the retirement plan trust and an asset of that trust since the trust actually purchases the disability

Art Unit: 2175

policy. In addition, the disability plan benefits are payable back into the trust. The paid disability benefits can be set to match the contribution payments (by insuring 100% of the contributions, see col. 24, lines 18-19.

Claims 47-48: Col. 7, lines 3-24 states that the plan is intended to comply with the Section 401 Regulations.

Claim 49: The benefits of the disability insurance are re-invested back into the trust (col. 9, lines 21-24).

Claim 50: The system may comply with certain IRC regulations (col. 10, lines 1-37).

Claim 52 and 54: The system is meant to comply with IRC regulations (col. 10, lines 1-37) and non-discrimination requirements (col. 7, lines 8-29).

Claim 55: The benefits of the disability insurance are based upon contributions to the plan. Any benefit amount derived from the disability insurance is readable as a "fixed percentage of compensation", since the percentage itself is not defined.

Claim 56: Each participant in the plan would inherently have their own account, otherwise, there would be no way to determine what contributions were made by each individual.

Claim 57: Individual employees may pay annual premiums (col. 25, lines 28-29). The funds may derive from within the trust (col. 9, lines 21-22).

Claim 58: The premiums are paid from funds in the trust, which is readable as a "source".

Claim 59: The premiums can be paid from funds within the trust and are not limited as to when the premiums can be paid.

Claim 60: See remarks for claim 1.

Art Unit: 2175

Claim 61: An employee which is denoted as having funds within the trust is determined to be eligible for the trust. The system accounts for premiums paid (col. 25, lines 8-12) and benefits paid (col. 25, line 32). Premiums are taken from the trust assets (col. 9, lines 21-24).

Claim 62: See remarks for claim 50.

Claims 51, 53, 63 and 64 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

This office action is non-final.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell  
Primary Examiner  
Art Unit 2175